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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TRAN, PHILIP B

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 03/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/594,786

Applicant(s)
Ingram Et. Al.

Examiner
Philip B. Tran

Art Unit
2155



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 10, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Response to Amendment

1. This office action is responsive to the amendment filed on October 12, 2001 and December 10, 2001. Claims 1, 11 and 19-21 have been amended with minor changes. Claims 22-63 have been newly added. Examiner requests that applicants should provide information about specific pages and columns of specification which supports the new claimed features. Therefore, claims 1-63 are presented for further examination.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

A/ Applicant argued that the cited prior art (Rosen et al, U.S. Pat. No. 5,995,102) teaches away from the claimed invention.

In response to applicant's arguments, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it.

Kalman v. Kimberly-Clark Corp., 218 USPQ 789.

Applicant's arguments are not found persuasive. Claim 1 is taken as an example for illustration purpose. Rosen teaches a method comprising displaying a toolbar if a pointer is proximate the hyperlink for a time period which exceeds a predetermined time, the toolbar displaying at least one user-selectable link enhancement, and in response to a users selection of a selected link enhancement, performing the selected link enhancement (i.e., displaying option

“click here” when the mouse cursor is moved over the banner advertisement which is in the form of a hyperlink and if the user choose the option it will link to some other screen windows) [see Col. 1, Lines 25-40].

As a result, Rosen does disclose a system and method for displaying a toolbar if a pointer is proximate the hyperlink then a link enhancement is selected, as broadly claimed by the applicant. Applicant clearly has failed to identify specific claim limitation that would define a patentable distinction over Rosen. Moreover, the term “user-selectable link enhancement” is very broad term and it can be interpreted in many ways and, of course, the link enhancement can be selected by the user by using the mouse cursor to click on.

B/ Applicant argued that obviousness is based upon impermissible hindsight reasoning

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Therefore, the examiner asserts that Rosen teaches or suggests the subject matter broadly recited in independent claims as required under 35 U.S.C. 102(e). Dependent claims are also anticipated or obvious at least by virtue of their dependencies and by other reasons set forth in the previous office action [see Paper No. 7]. Accordingly, claims 1-63 are respectfully rejected.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 11, and 19-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Rosen et al (Hereafter, Rosen), U.S. Pat. No. 5,995,102.

Regarding claim 1, Rosen teaches a method comprising displaying a toolbar if a pointer is proximate the hyperlink for a time period which exceeds a predetermined time, the toolbar displaying at least one link enhancement, and in response to a users selection of a selected link enhancement, performing the selected link enhancement (i.e., displaying option "click here" when the mouse cursor is moved over the banner advertisement which is in the form of a hyperlink and if the user choose the option it will link to some other screen windows) [see Col. 1, Lines 25-40].

Claims 11 and 19-21 are rejected under the same rationale set forth above to claim 1.

5. Claims 22, 32, 40-43, 53, 61-63 are rejected under 35 U.S.C. § 102(a) as being anticipated by Microsoft Homepage (Hereafter, MH), Feb 28, 2000.

Regarding claim 22, MH teaches a method for enhancing a hyperlink comprising displaying a toolbar if a pointer is proximate the hyperlink for a time period which exceeds a predetermined time, the toolbar displaying at least two link enhancement, and in response to a users selection of a selected link enhancement, performing the selected link enhancement (i.e., displaying several options when the mouse cursor is moved over the portion "downloads" of a toolbar which is in the form of a hyperlink and if the user choose the one of the options it will link to some other screen windows) [see Page 1].

Claims 32, 40-43, 53, and 61-63 are rejected under the same rationale set forth above to claim 22.

Claim Rejections - 35 U.S.C. § 103

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2-10 and 12-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosen et al (Hereafter, Rosen), U.S. Pat. No. 5,995,102.

Regarding claim 2, Rosen does not explicitly teach the at least one link enhancement displayed comprises at least one of : open in new window, open in new window minimized, check it later, or anchor current page. However, the use of options for opening a new window, resizing a window and anchoring the current page is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement icons or buttons displaying a variety of link selections in order to provide a friendly use.

Regarding claims 3-10, Rosen does not explicitly teach performing the selected link enhancement comprises: opening the page associated with the selected link in a new browser window, minimizing the new browser window without any user action, creating a clickable item such as label or image in a window associated with the selected hyperlink. However, the use of clickable items in a window associated with the hyperlinks for opening a new page or minimizing a window is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement icons or buttons displaying a variety of link selections for the same reasons set forth above to claim 2.

Claim 12 is rejected under the same rationale set forth above to claims 2.

Claims 13-18 are rejected under the same rationale set forth above to claims 3-10.

8. Claims 23-31, 33-39, 44-52, and 54-60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Microsoft Homepage (Hereafter, MH), Feb 28, 2000.

Regarding claim 23, MH does not explicitly teach the at least one link enhancement displayed comprises at least one of : open in new window, open in new window minimized, check it later, or anchor current page. However, the use of options for opening a new window, resizing a window and anchoring the current page is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement icons or buttons displaying a variety of link selections in order to provide a friendly use.

Regarding claims 24-31, MH does not explicitly teach performing the selected link enhancement comprises: opening the page associated with the selected link in a new browser window, minimizing the new browser window without any user action, creating a clickable item such as label or image in a window associated with the selected hyperlink. However, the use of clickable items in a window associated with the hyperlinks for opening a new page or minimizing a window is well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement icons or buttons displaying a variety of link selections for the same reasons set forth above to claim 23.

Claims 33, 44 and 54 are rejected under the same rationale set forth above to claim 23.

Claims 34-39, 45-52 and 55-60 are rejected under the same rationale set forth above to claims 24-31.

Other References Cited

9. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

- A) Brown, U.S. Pat. No. 5,914,714.
- B) Gennaro et al, U.S. Pat. No. 5,742,768.
- C) Linux-Hacker.net Homepage, May 05, 2000.

Conclusion

10. Applicants' amendment necessitates the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

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Paper No. 11

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (703) 308-8767. The Group fax phone number is (703) 746-7239.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh, can be reached on (703) 305-9648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

PBT
Philip Tran
Art Unit 2155
Feb 21, 2002


DAVID WILEY
PRIMARY EXAMINER